

PATENT  
Docket NCR11393

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

*Applicant:*  
D. E. Bostdorf

)  
)  
) *Art Unit:* 3651  
)

*Application No.:* 10/668,381  
*Confirmation No:* 6065

)  
) *Examiner:* Mackey, P.  
)

*Filed:* 09/23/2003  
)

*Title:* Offset Diecut Stack

**Provisional Election**

Mail Stop Non-Fee Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the office action dated as mailed on 05/19/05, and having a period of response extending through and including 06/19/05, Applicant provisionally elects claim group I and claims 1-12 and 20 presently included therein, with traverse.

The restriction requirement recognizes that the three groups correspond with all three categories "product, process of making, and process of use," as found in Rule 141(b).

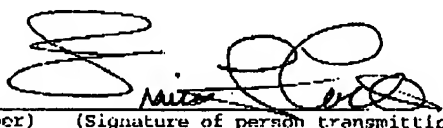
That rule mandates that "a three way requirement for restriction can only be made where the process of making is distinct from the product." See also, MPEP 802.01 on the applicable meanings.

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**CERTIFICATE OF TRANSMISSION (37 CFR 1.8a and MPEP 512)**

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FRANCIS L. CONTE  
(Name of person transmitting paper)

  
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7 June 2005  
(Date)

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In para. 3 of the office action the examiner has failed to meet this test of Rule 141(b) that "the process of making is distinct from the product," since it is not possible to meet this test because the method of making claims 13-16 of Group III are expressly dependent from product claim 3, and therefore include all the features thereof.

Accordingly, Rule 141(b) is dispositive of the restriction requirement and mandates under the present facts that "the process of using may be joined with the claims directed to the product and the process of making the product even though a showing of distinctness between the product and the process of using the product can be made."

The entire three-way restriction requirement must therefore be withdrawn.

Furthermore, Rule 141(a) permits a reasonable number of species claims as the exception to restriction; and the method of using claims of Group II and the method of making claims of Group III are species claims dependent from the common or generic product claim 3. See also MPEP 806.04(b) and 806.04(d).

Since Groups II & III clearly contain a reasonable number of species claims, also Rule 141(a) requires withdrawal of the restriction requirement.

As for para. 1 of the office action, the class 270/32 is listed in the Manual of Classification for associating and folding which appears to have no relevancy to the process of printing recited in Group II.

And, the class 83/84 relates to means to form or hold a pile of product pieces, which also appears to have no relevancy to the process of making sheets recited in Group III.

More importantly, both Groups II & III recite by dependence the product claims of Group I which would necessarily require any examiner to conduct the search at least in the Group I area, with additional search in

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ancillary classes.

Accordingly, the separate classification contention proffered by the examiner does not appear relevant under the present facts.

As for para. 2 of the office action the examiner's example of "credit cards" is not relevant to the claims which expressly recite "sheets." And, the examiner's contention of "holding credit cards in an unprinted state," does not appear to be a materially different process of using since printing is such a ubiquitous and well-known process.

The examiner has not shown that claim 17 would be patentable solely because of the printing step therein, and therefore a division application would be warranted.

The examiner has not shown that merely "holding the credit cards in an unprinted state" would also be separately patentable, and appears dubious. How would the sheets recited in claim 3 be separately patentable both as the products they are, and in the (negative) method proposed by the examiner as being merely held in an unprinted state?

As for para. 3 of the office action, the examiner has not shown that "being cut in a non-web form" is a different process at all, let alone a materially different process.

Method claim 13 is entitled to the typical broad interpretation thereof customary in examination practice before the USPTO, and the examiner has not shown that his "non-web" example is different in any manner from the recited "web" example. The examiner has overlooked in claim 13 that the sheets of claim 3 are being made, and there are many embodiments of the web and corresponding sheet.

As for para. 4, the examiner has mischaracterized the claims in groups II & III as "subcombinations."

The subcombination in groups II & III is the common product claim 3 from which both groups depend. Ipso facto, the claims in groups II & III are combination claims based on a common subcombination.

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MPEP 806.05(d) being applied by the examiner is therefore incorrect.

Instead, MPEP 806.05(c) specifically addresses combinations and subcombinations, and requires that "two-way distinctiveness must be demonstrated."

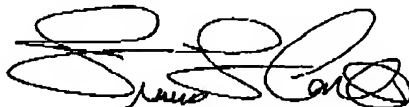
Under this section, the examiner cannot show that the "combination as claimed" in claim groups II & III "(A) does not require the particulars of the subcombination as claimed" since those groups expressly depend from product claim 3.

MPEP 809.03 is also applicable for the clear linking claims of the product genus and linked processes of making and using.

Lastly, MPEP 821.04 mandates rejoinder of the process claims of Groups II & III upon allowance of the product claim.

Withdrawal of the restriction requirement is therefore warranted for these several reasons, and is respectfully requested.

Respectfully submitted,



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Date: 7 June 2005

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